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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,842	12/09/1999	SATORU SAWADA	12924(JA998-	8134

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EXAMINER
SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/457,842	SAWADA ET AL.
	Examiner	Art Unit	
	Cristina Owen Sherr	3621	~~w~~

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 July 2004</u>.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-8,10-16 and 21-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-8,10-16 and 21-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to the Applicant's Amendment filed July 23,

2004. Claims 1-3, 10 and 13 have been amended. Claims 9 and 17-20 have been

canceled. Claim 24 is newly added. Claims 1-8, 10-16 and 21-24 are pending in this

case.

Response to Arguments

2.   Applicant's arguments filed July 23, 2004 have been fully considered but they are

not persuasive.

3.   Applicant argues, with respect to claims 1-8, 10-16, and 21-23 That Downs does

not disclose charging for downloaded data. Attention is directed to Downs (US

6,226,618131) at, e.g., col 8 ln 7-15, col 3 ln 40-56, col 7 ln 40-55. Applicant further

argues that Downs does not disclose or suggest a recording medium that includes both

recognition data that is used to identify the type of data downloaded and charging data

relating to paying for the downloaded data. Attention is directed to Downs (US

6,226,618131) at, e.g., col 7 ln 56-col 8 ln 5.

Claim Rejections - 35 USC § 102

4,   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 21, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by

Downs et al (US 6,226,618131).

6.   Regarding claim 1 -

Downs discloses a data charging system for charging for the use of object data, the

system comprising: a content generator for generating contents containing object data

of a specific type, a charge recording medium for recording charging data used for

paying for said object data and recognition data used for identifying the specific type of

the object data in said contents, and a data charging apparatus for charging for the use

of said object data by using said charging data and said recognition data which have

been recorded; wherein said data charging apparatus comprises: data reading logic for

reading out said recognition data and said charging data from said recording medium,

a separator for separating said object data from said contents, a recognition logic for

identifying the specific type of said separated object data by using said recognition data

which has been read out from the recording medium, an accounting logic for

dynamically charging for the use of said separated object data, based on the specific

type of data said separated object data is, and by using said charging data which has

been read out from the recording medium, and a writing logic for writing, as part of said

charging data in the recording medium, the results of charging for the use of said

separated object data (e.g. col 8 ln 7-15, col 3 ln 40-56, col 7 ln 40-55).

7.   Regarding claim 21 -

Downs discloses a data charging system according to claim 20, wherein the content generator generates watermark information about the digital watermark and also embedded in said contents (e.g. col 7 ln 56-col 8 ln 5).

8.   Regarding claim 24 –

Downs discloses a data charging system according to claim 1, wherein: the content generator also puts recognition data in said contents; and the object data is identified based on the recognition data in said contents and said recognition data read from the recording medium (e.g. col 3 ln 40-56).

9.   Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

Downs discloses a content generator for embedding digital watermarks in object data of a specific type and generating contents in a data charging system which records, on a charge recording medium, the charging data used for paying for object data contained in said contents and the recognition data used for identifying the specific type of the object data in said contents and charges only for the use of the object data embedded with said digital watermarks, based on the specific type of data said object data is, and, by using said charging data and said recognition data recorded (e.g. col 7 ln 56-col 8 ln 5).

10.   Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

11.   Regarding claim 3-

Downs discloses a data charging system which records, on a charge recording medium,

the charging data used for charging for object data of a specific type and contained in

said contents and the recognition data used for identifying the specific type of the object

data in said contents charges for the use of said object data by using said charging data

and said recognition data recorded, a data charging apparatus comprising: a data

reading logic for reading said recognition data and said charging data from said

recording medium, a separator for separating said object data from said contents, a

recognition logic for identifying the specific type of said separated object data by using

said recognition data read out, an accounting logic for charging for the use of said

separated object, based on the specific type of data said separated object data is, and

data by using said charging data read out, and a writing logic for writing, as part of said

charging data in the recording medium, the results of charging for the use of said

separated object data (e.g. col 11 ln 1-28).

12.   Regarding claim 4 -

Downs discloses the data charging apparatus according to Claim 3, wherein said

contents comprise said object data and said recognition data for recognizing this object

data, said separator separates said object data and said recognition data from said

contents, said recognition logic recognizes said object data, based on said recognition

data separated from said contents and on said recognition data read out from said

recording medium, and said accounting logic charges for said object data by using said

charging data read out (e.g. col 7 ln 56-col 8 ln 5).

13.   Regarding claim 5 -

Downs discloses the data charging apparatus according to Claim 3, further comprising a

watermarking logic for embedding digital watermarks in said object data separated from

said contents, wherein said separator separates said object data and said recognition

data from said recognition logic recognizes said object data, based on said recognition

data separated from said contents and on said recognition data read out from said

recording medium, and said accounting logic charges for said object data embedded

with said digital watermarks (e.g. col 7 ln 40-65).

14.   Regarding claim 6 -

Downs discloses the data charging apparatus according to Claim 3, wherein a digital

watermark is embedded in said object data in said contents, said data charging

apparatus further comprising a means for detecting if said object data is embedded with

said digital watermark, said separator separating said object data and said recognition

data from said contents, said recognition logic recognizing said object data, based on

said recognition data separated from said contents and on said recognition data read

out from said recording medium, and said accounting logic charging for said object data

only if said object data is found to be embedded with said digital watermark (e.g. col 7 ln

56-col 8 ln 5).

15.   Regarding claim 7 -

Downs discloses the data charging apparatus according to Claim 3, wherein said

charging data recorded on said recording medium contains at least payment data which

indicates the payment made in advance for the use of said object data, and said

accounting logic charges for the use of said object data within the limits of the amount
indicated by said payment data contained in said charging data (e.g. col 8 ln 6-15).

16.   Regarding claim 8 -

Downs discloses the data charging apparatus according to Claim 7, wherein said
charging data recorded on said recording medium further contains unit price data
representing the accounting unit for the use of said object data and the price
corresponding to the accounting unit, said data charging apparatus comprising an
accounting unit detection logic for detecting unit accounting amount data which
represents the amount of said accounting unit for the object data separated from said
contents, said accounting logic charging within the limits of the amount indicated by said
payment data, based on said unit price data contained in said charging data read out
and on the unit accounting amount data detected (e.g. col 11 ln 15-28).

17.   Claims 10-12 and 22-23 are rejected under 35 U.S.C. 102(e) as being
anticipated by Downs et al (US 6,226,618131).

18.   Regarding claim 10 -

Downs discloses a data charging method for generating contents which contain object
data of a specific type and recognition data used for the identification of the specific type
of this object data in the generated contents, recording, in a charge recording medium,
the charging data used for charging for said object data and the recognition data used
for identifying the specified type of the object data, and charging for the use of said
object data by using said charging data and said recognition data recorded, comprising
the steps of reading said recognition data and said charging data from said recording

medium, separating said object data from said contents, identifying the specified type of

said separated object data by using said recognition data read out, dynamically

charging for the use of said separated object data, based on the specific type of data

said object data is, and by using said charging data read out from the recording

medium; and writing into the recording medium, as part of said charging data, the

results of charging for the use of said recognized object data (e.g. col 10 ln 50 - col 11

ln 28).

19.   Regarding claim 11 -

Downs discloses a data charging method according to Claim 10, wherein said object

data in said contents are embedded with digital watermarks, comprising the steps of

separating said object data and said recognition data from said contents; recognizing

said object data, based on said recognition data separated from said contents and on

said recognition data read out from said recording medium; detecting said digital

watermark embedded in said object data; and charging for said recognized object data

only by using said charging data read out if said object data is found to be embedded

with said digital watermark (e.g. col 7 ln 56-col 8 ln 5).

20.   Regarding claim 12 -

Downs discloses a data charging method according to Claim 10, comprising the steps

of separating said object data and said recognition data from said contents recognizing

said object data, based on said recognition data separated from said contents and on

said recognition data read out from said recording medium; embedding digital

watermarks in said separated object data; and charging for the use of the object data

embedded with said digital watermarks by using said charging data read out (e.g. col 7

ln 56-col 8 ln 5).

21.   Regarding claim 22 -

Downs discloses a method according to claim 11 further comprising the step of

embedding in said contents information about the digital watermark (e.g. col 8 ln 1-5)

22.   Regarding claim 23 -

Downs discloses a method according to claim 22 wherein the embedding step includes

the step of embedding in said contents instructions for embedding the contents with

said digital watermarks (e.g. col 7 ln 56-col 8 ln 5).

23.   Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs

et al (US 6,226,618131).

24.   Regarding claim 13 -

Downs discloses a data charging apparatus of a data charging system which records,

on a charge recording medium, the charging data used for charging for the object data

of a specified type and contained in contents and the recognition data used for

identifying the specified type of the object data in said contents, and charges for the use

of said object data by using said charging data and said recognition data recorded; a

computer program product enabling a computer to execute the steps of reading said

recognition data and said charging data from the recording medium, separating said

object data from said contents, identifying the specified type of said separated object

data by using said recognition data read out, dynamically charging for the use of said

separated object data, based on the specific type of data said separated object data is,

and by using said charging data read out from the recording medium, and writing into

the recording medium, as part of said charging data, the results of charging for the use

of said recognized object data into said recording medium (e.g. col 11 ln 1-28).

25.   Regarding claim 14 -

Downs discloses the computer program product according to Claim 13, wherein said

contents contain said object data and said recognition data used for recognition of the

object data, said object data and said recognition data are separated from said contents

in said separation step, said object data is recognized in said recognition step, based on

said recognition data separated from said contents and on said recognition data read

out from the recording medium, and a charge is made for said object data in said

charging step by using said charging data read out (e.g. col 11 ln 1-28).

26.   Regarding claim 15 -

Downs discloses the computer program product according to Claim 13, wherein the

computer is made to execute the step of embedding digital watermarks in said object

data separated from said contents, said object data and said recognition data are

separated from said contents in said separation step, said object data is recognized in

said recognition step, based on said recognition data separated from said contents and

on said recognition data read out from the recording medium, and a charge is made for

said object data embedded with said digital watermarks in said charging step (e.g. col 7

ln 56-col 8 ln 5).

27.   Regarding claim 16 -

Downs discloses the computer program product according to Claim 13, wherein said

object data in said contents are embedded with digital watermarks, the computer is

further made to execute the step of detecting that said object data is embedded with

said digital watermarks, said object data and said recognition data are separated from

said contents in said separation step, said object data is recognized in said recognition

step, based on said recognition data separated from said contents and on said

recognition data read out from the recording medium, and a charge is made for said

object data in said charging step only if said object data is found to be embedded with

said digital watermark (e.g. col 7 ln 56-col 8 ln 5).

28.   Examiner's note: Examiner has cited particular columns and line numbers in

the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may be applied as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Conclusion

29.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

30.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

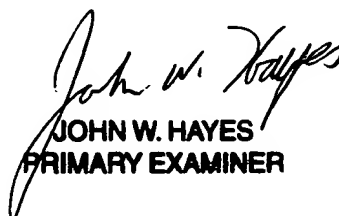TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

32.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

33.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN W. HAYES
PRIMARY EXAMINER